

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS L. MCLAUGHLIN
and CAROL A. CALDWELL

Appeal No. 1999-2630
Application 08/341,464

ON BRIEF

Before PATE, MCQUADE, and CRAWFORD, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Thomas L. McLaughlin et al. originally took this appeal from the final rejection of claims 6, 9, 10, 13 and 14. The appellants have since canceled claims 10, 13 and 14, and added claims 15 and 16 which were allowed by the examiner (see the advisory action dated April 17, 1997, Paper No. 26). Thus, the appeal now involves claims 6 and 9. Claims 1 through 5, the

only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

THE INVENTION

Independent claim 6, and claim 9 which depends therefrom, pertain to a diaper having adhesive fastener tapes with lift tabs defined by printed adhesive-inhibiting masks. Claim 6 reads as follows:

6. In a diaper having adhesive fastener tapes, each fastener tape having a width and being cut from fastener tape stock having a length, said cut being such that the width direction of the fastener tape corresponds to the length direction of the stock, each fastener tape having substrate means for providing a substrate, said substrate means having an inner and an outer end and being fastened at its inner end to one part of the diaper, each tape having a pressure-sensitive adhesive face at least at the outer end of said substrate means, said adhesive face being carried on release means for providing a release face, said release means in turn being carried on said one part of the diaper, said substrate means being adapted to have its outer end peeled from and thereby deployed from said one part of the diaper for fastening to another part of the diaper to thereby establish a user joint and fasten the diaper, said user joint being openable by peeling said outer end from said another part of the diaper, being refastenable by reapplying said outer end to said another part of the diaper to reestablish said user joint, and being reopenable following said refastening, said adhesive face being liftably peelable from said release face of said release means to effect said deployment, the outer end of said substrate means having an easy-start peelback lift tab for initiating said peeling of said outer end, the improvement comprising providing said easy-start peelback lift tab in the form of a printed adhesive-inhibiting lifttable masking means for

inhibiting adherence of the adhesive face, said outer end of said substrate means having an outermost part, said printed masking means being provided on the adhesive face at said outermost part of said outer end, said printed masking means being in contact with said release face, said printed masking means extending across said width of said tape whereby said printed masking means is cut from a printed masking means continuum extending along the length of said fastener tape stock, said printed masking means

being peelable and liftable from said release face along with said adhesive face for easy-start initiation of said peeling from said one part of the diaper, and said printed masking means being thereafter reusable both (1) to open said user joint and (2) to subsequently reopen said user joint after refastening thereof.

THE REJECTIONS

Claims 6 and 9 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification lacking original support for the invention now claimed.

Claims 6 and 9 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,801,480 to Panza et al. (Panza) in view of U.S. Patent No. 4,107,811 to Imsande and U.S. Patent No. 3,874,893 to Cherrin.

Reference is made to the appellants' main, reply and supplemental reply briefs (Paper Nos. 29, 35 and 41) and to the examiner's answer (Paper No. 40) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, first paragraph, rejection

The examiner's explanation (see pages 5, 6 and 8 in the answer) indicates that this rejection rests on an alleged failure of the appellants' specification to comply with the written description requirement with respect to the limitations in independent claim 6 requiring the user joint to be openable, refastenable and reopenable.

The test for compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

As pointed out by the appellants (see page 11 in the main brief), claim 10 in the application as originally filed recited a diaper fastener formed of a web construction of linerless "reclosable" diaper fastener stock. Read in light of the underlying specification, the term "reclosable" clearly

describes the diaper fastener formed from the stock, not the stock itself

as urged by the examiner. Furthermore, given the manner in which the original specification (see pages 15 and 16 and the incorporation by reference on page 15 of U.S. Patent No.

4,020,842 to Richman et al.) employs the term "reclosable" in its

description of the diaper fastener shown in Figure 12,¹ one of ordinary skill in the art would understand the appellants' use of this term as being generally descriptive of a fastener which can be opened and closed a plurality of times. Hence, the content of original claim 10, considered in conjunction with the rest of the originally filed disclosure, would reasonably convey to the artisan that the appellants had possession at that time of a diaper as recited in claim 6 including a user joint which is openable, refastenable and reopenable.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 6 and 9.

¹ Although the appellants are of the view that "Figure 12 relates to a . . . fastener embodying the subject matter of the claims" (main brief, page 2), it is not readily apparent how the limitations in appealed claim 6 can be read on a diaper having the fasteners shown in Figure 12.

II. The 35 U.S.C. § 103(a) rejection

Panza, the examiner's primary reference, discloses a composite adhesive tape 11 (see Figures 1 and 2) for connecting opposing edges 30, 35 of a diaper (see Figures 3 through 5). The tape includes bonded and fastening sections 16 and 17 defined by a fastening tape 12, a target tape 18, a release tape 21 and a unifying strip 24. The composite tape also includes a first fingerlift strip 20 positioned between and extending outwardly of the fastening tape and the target tape for facilitating separation of the fastening tape from the target tape, and a second fingerlift strip 23 attached to and extending outwardly of the target tape for facilitating separation of the target tape from the release tape.

The appellants have not disputed the examiner's determination (see page 6 in the answer) that Panza responds to all of the limitations in claim 6 except for those relating to the printed adhesive-inhibiting masking means.

Imsande discloses a tacky floor mat for use in hospitals, industrial clean areas and like applications to remove loose particles of dirt, dust and soil from shoes, wheels, etc. The mat 10 consists of a stack 12 of adhered, peelable sheets 14,

each having a layer of pressure-sensitive adhesive 16 on its upper surface, whereby the upper sheet can be peeled from the stack to expose a fresh sheet. To facilitate the peeling, at least one corner of each sheet includes a thin coating of non-adhesive material 18, 26, 29 print deposited on the adhesive layer (see column 2, lines 40 through 53; and column 3, lines 57 through 62). Imsande teaches that these printed non-adhesive coatings are superior to gripping tabs attached to the sheets because they add less bulk or thickness and allow for rapid and efficient fabrication of the mat (see column 1, lines 40 through 52; column 2, lines 12 through 23; column 3, line 62, through column 4, line 10; and column 4, lines 24 through 27).

Cherrin discloses an adhesive tape product for affixing shipping documents to the sides of shipping containers. In the embodiment shown in Figures 12 and 13, a corner of the tape product 50 includes a non-tacky coating 56 printed over the adhesive to form a lift-off tab which facilitates manual grasping and removal of the tape product from a shipping container. According to Cherrin, the printed coating has the

advantage of eliminating the need for relatively thick layers of paper, plastic or foil to neutralize the tackiness of the adhesive (see column 5, lines 60 through 65).

In proposing to combine Panza, Imsande and Cherrin to reject claim 6, the examiner concludes that "[t]o employ a masking means as taught by Imsande and Cherrin on the Panza et al device would [have been] obvious to one of ordinary skill in the art in view of the recognition that such a feature would be thinner and/or more economically efficient" (answer, page 7). Presumably, this modification would involve the replacement of Panza's fingerlift strips 20 and 23 by printed adhesive-inhibiting masking means, thereby arriving at the subject matter recited in claim 6.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill

in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The disclosures by Imsande and Cherrin of the benefits of printed adhesive-inhibiting masks as compared to relatively thick adhesive-blocking layers, and particularly Imsande's favorable comparison of such printed masks to fingerlift tabs of the general sort disclosed by Panza, would have provided the artisan with ample suggestion or motivation to replace Panza's fingerlift strips 20 and 23 with printed adhesive-inhibiting masking means. Thus, the combined teachings of Panza, Imsande and Cherrin belie the various lack of suggestion arguments advanced by the appellants. The related arguments that the proposed reference combination would destroy the fingerlift function and so-called "thickness balance" of Panza's diaper fasteners are also unpersuasive. Printed adhesive-inhibiting masks of the sort disclosed by Imsande and Cherrin would merely provide different fingerlift constructions on the Panza tape fasteners, not destroy the function thereof. Furthermore, Panza makes no mention of "thickness balance," and there is nothing in this reference to support the appellants' contention that the tape fastener stock

could not be wound into a roll without such "thickness balance." A cursory glance at Panza's Figures 1 and 2 clearly refutes any notion that "thickness balance" is important to Panza. The further argument that the proposed modification would not meet the limitation in claim 6 requiring the printed masking means to extend across the width of the tape is also unconvincing. Inasmuch as fingerlift strips 20 and 23 extend across the width of Panza's fastener tapes, so too would the printed masking means replacing these strips in order to make the tapes easier to grasp.

The appellants also submit that

[t]he unobviousness of applicant's [sic] present claimed combination is further evidenced by the numerous efforts of the prior art to furnish improved easy-start peel tabs, including the efforts by Panza, and by Cronkrite 4,299,223 of record, and by the references discussed at pages 3 and 4 of the specification, namely Reed et al., Karami, Pape, and Mesek, extending over a period at least from the early 1970's. Despite those efforts, and despite the publication of the Imsande patent more than 15 years ago, and the Cherrin patent more than 18 years ago, until the present invention no one came up with applicants' claimed significantly improved "easy-start" tabs for diaper fastener tapes. Applicants supported

this evidence of unobviousness by submitting the declaration of Thomas L. McLaughlin, one of the inventors in the present case [main brief, page 22].

At best, the McLaughlin declaration and the references noted by the appellants show no more than a generalized "continuing need for product improvement in the diaper tab field, including a need to improve fingerlift arrangement[s] for diaper tabs" (declaration, page 4). To establish long felt need as an indicator of non-obviousness, objective evidence must be presented which demonstrates the existence of a problem which has been recognized in the industry and has remained unsolved over a long period of time. See Vandenberg v. Dairy Equip. Co., 740 F.2d 1560, 1567, 224 USPQ 195, 199 (Fed. Cir. 1984). Once this long felt need has been established, it must further be shown that the claimed invention satisfied that need. See In re Cavanagh, 436 F.2d 491, 496, 168 USPQ 466, 471 (CCPA 1971). The appellants' evidence establishes neither a recognized long-felt problem or that the claimed invention solved such a problem. Moreover, the mere age of the references is not persuasive of the unobviousness of their combination absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve a particular problem. See In re Wright, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977). As indicated above,

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the record contains no such evidence. The record also lacks any substantiation for the appellants' assertion that the claimed invention significantly improved diaper fastener tabs.

In light of the foregoing, the totality of evidence before us supports the examiner's conclusion that the differences between the subject matter recited in claim 6 and the prior art are such that the subject matter as whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 6 as being unpatentable over Panza in view of Imsande and Cherrin.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 9 as being unpatentable over Panza in view of Imsande and Cherrin since the appellants have not challenged such with any reasonable specificity, thereby allowing claim 9 to stand or fall with parent claim 6 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

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SUMMARY

The decision of the examiner to reject claims 6 and 9 is affirmed with respect to the 35 U.S.C. § 103(a) rejection, and reversed with respect to the 35 U.S.C. § 112, first paragraph, rejection.

AFFIRMED

WILLIAM F. PATE, III)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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